

**Office Action Summary****Application No.**

09/761,040

**Applicant(s)**

SALMI ET AL.

**Examiner**

YEMANE MESFIN

**Art Unit**

2444

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 October 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 1,3,4,6-12 and 14-26 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1,3,4,6-12 and 14-26 is/are rejected.
- 8) ☒ Claim(s) 14 is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 12/21/2011
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

### **DETAILED ACTION**

The response filed on 10/11/2011 has been received and made of record. Claims 1, 3, 4, 6-12 and 14-26 are pending.

#### ***Response to Arguments***

Applicant's argument see argument reproduced below, filed on 10/11/2011, with respect to the validity of the recited prior art Fischer has been fully considered and is persuasive. Therefore, the Fischer reference has been withdrawn accordingly.

The applicant recites, "Applicants respectfully submit that Fischer is not a valid reference. The present application claims priority to Finnish Application No. 20000089, filed on 17 January 2000 and thus has an effective filing date of 17 January 2000. Fischer is the National Stage of PCT/DE99/01733, filed on 14 June 1999, prior to 29 November 2000. Therefore, the earliest date Fischer is effective as a reference is its publication date of 15 June 2000. Because this is after the effective filing date of the present application, Fischer is not a valid reference for the present application" (see Remark Page 7).

However, upon further consideration, a new ground(s) of rejection is made in view of Miller et al. US Patent # 6,421,707.

#### ***Claim Objections***

Claim 14 is objected to because of the following informalities: Claim 14, claim line 4, recites, "the [a] message set up block", which should be corrected to read as "the message set up block". Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12, 14-20, 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Each of claims 12, 21 and 22 recite an apparatus/terminal comprising functional blocks (see for instance claim 21 calling for a terminal comprising: a user interface..., a modification block..., a compiling block... and a message setup block), which may be interpreted by one of ordinary skill in the art to mean merely software modules. Thus, these claims are not limited to statutory embodiment. For a claim to be qualified as a machine, as in the four categories of invention, the claimed apparatus/terminal should clearly define at least one hardware component in order to fall within the meaning of a machine.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6-12 and 14-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Jaisimha et al. (U.S. Patent Number 6,487,663) hereinafter “Jaisimha” in view of Jerding et al., (US Patent Number 7,308,697) hereinafter referred to as “Jerding” and further in view of Miller et al., (US Patent No. 6,421,707) hereinafter referred to as “Miller”.

As per claim 1, Jaisimha disclosed a method comprising: using a transmitting device for: defining presentation parameters for at least one multimedia component included in first message (column 7 lines 18-25), the first message comprising address data indicative of a transmitter and a recipient of the first message (column 8 lines 48-50 and column 9 lines 56-67); determining a reference to a location of said the at least one multimedia component within the first message (column 7 lines 18-25, having therein a location reference to the enclosed components in the message); determining a format of the at least one multimedia component within the first message; and, supplementing the first message with a file comprising the presentation parameters and the reference, and a header information indicating the format to form a second message.

Jaisimha disclosed the invention substantially as recited. However, does not explicitly recite “supplementing the first message with a file comprising the presentation parameters and the reference to form a second message”. However, as evidenced by the teachings of Jerding, supplementing one message with a file comprising presentation parameters and the reference to form a second message was known in the art at the time the invention was made (see at least Jerding, column 2 lines 58-60, column 3 lines 27-39, column 4 lines 26-45 and column 7 lines 19-45, Jerding disclosed receiving a first message with selected presentation parameters for presentation of a message and supplementing the message with a presentation file having therein presentation parameters included therein to generate a second message, the second message comprising the attached message component and corresponding presentation file integrated all together as one message). Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art to take the teachings of Jerding related to formation of a second message, the second message comprising the attached message component and corresponding presentation file integrated all together as one message as described above and have modified the teachings of Jaisimha with a

motivation to “create a message configuration which defines how the message content is presented to the subscribers/users” (see Jerding column 6 lines 9-10).

The already combined teachings of Jaisimha and Jerding disclosed the invention substantially as recited in the claim. However, was silent about determining a format of the at least one multimedia component via header information indicating the format. However, in the same field of invention, Miller teaches mobile to mobile multimedia messaging (see Miller abstract) transmitting multimedia messages from a sender to a recipient (Miller abstract, column 1 lines 40-62), determining a format of the at least one multimedia component via header information indicating the format (see Miller column 3 lines 16-20, a multimedia message format specified by a subscriber, with the ability to communicate a variety of multimedia formats from an originating communicating party to a receiving party as indicated by the transmitting party in header message configuration (see column 4 lines 31-51)). Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Miller related to determining different formats within a message by utilizing a header information that indicates multiple file formats of a message and have modified the already combined teachings of Jaisimha and Jerding with a motivation to enhance the ability to communicate a variety of multi-media formats from an originating communicating party to a receiving party (see Miller column 4 lines 38-40).

As per claim 3, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, receiving the first message at a multimedia message service center of a multimedia message transmission system; and, supplementing the first message with the file at the multimedia message service center (Jaisimha Figure 3, showing a multimedia server “MMSC”

sending multimedia messages to a mobile station and, See Column 7, Lines 1-23 a presentation model of W3C's used in presenting the multimedia messages at a mobile user terminal).

As per claim 4, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, further comprising forming the file using an SMIL format (Jaisimha column 7 lines 1-23).

As per claim 6, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the reference comprises a search address of the at least one multimedia component (Column 7, Lines 18-19, Jaisimha disclosed a "src" or a source of the components used to search and execute the components contained in the message and See Figure 3, showing a remote search locations for the components to be played or displayed on the mobile terminal).

As per claim 7, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the at least one multimedia component comprises visual information, and the presentation parameters comprise information about displaying the at least one multimedia component (Jaisimha column 7 lines 18-19; see also Jerding column 6 lines 7-28 & column 7 lines 19-43)

As per claim 8, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the at least one multimedia component comprises audio information and the presentation parameters include data about converting the at least one multimedia component onto audio information (Jaisimha column 7 lines 1-23)

As per claim 9, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the presentation parameter include information about a time of effect

of the at least one multimedia component (This limitation is inherent future of the known presentation model SMIL [Synchronized Media Integration Language], according to the specification of SMIL 1.0 published in 1998; W3C defines SMIL as “a markup language designed to present multiple media files together. For instance, instead of using a video with an integrated soundtrack, a separate video and sound file can be used and synchronized via SMIL. This allows users to choose different combinations, e.g., to get a different language sound track, and permits text transcripts to be optionally presented; both options have accessibility benefits.” SMIL allows integrating a set of independent multimedia objects into a synchronized multimedia; see also Jerding column 7 lines 19-45).

As per claim 10, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the first message comprises at least two parameters include information about the mutual synchronization of the at least two multimedia components (This claim limitation is rejected for the same reason claim 9 is rejected above).

As per claim 11, the already combined teachings of Jaisimha and Jerding disclosed the invention as recited, wherein the first message comprises at least two multimedia pages, and the presentation parameters include data about the order of presenting the at least two multimedia pages (Jaisimha Column 7, Lines 18-19; and Jerding column 7 lines 19-45).

Claims 12, 14-26 recite limitations substantially the same as in claims 1-4 and 6-11 disclosed above. Thus, these claims are rejected with the same rationale claims 1-4 and 6-11 are rejected above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YEMANE MESFIN whose telephone number is (571)272-3927. The examiner can normally be reached on M- F, from 9 to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pappas Peter-Anthony can be reached on 572-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Yemane Mesfin/  
Primary Examiner, Art Unit 2444